

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-36 are pending in the application, with claims 1, 9 and 12 being the independent claims. Claims 9-33, 35 and 36 have been withdrawn from consideration. Claims 1, 4, 35 and 36 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Claims 1 has been amended by deleting "2" from the definition of n in Formula *I*. Applicants submit that no new matter has been introduced by this amendment since deletion of individual members of a Markush expression does not constitute new matter. *See, In re Johnson and Farnham*, 194 USPQ 187 (CCPA 1977).

Claims 35 and 36 have been amended by inserting the phrase "and n" so that it is clear that the definition for n in claims 35 and 36 are as defined in claim 1. These amendments are of a formal nature, and are believed to introduce no new matter.

Lastly, claim 4 has been amended by deleting the phrase "preferably methyl" and has been further amended by inserting the phrase "C₁-C₄" immediately before the term alkyl. Support for these amendments to claim 4 appears throughout the specification, including at page 5, line 12, and in claim 1 as originally filed.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner consider all outstanding objections and rejections and that they be withdrawn.

Information Disclosure Statement Filed on January 24, 2002

Applicants have not received an initialed, return-copy of Form PTO-1449 that was filed with the Information Disclosure Statement on January 24, 2002. Applicants respectfully request that the Examiner consider each of the references cited on Form PTO-1449, and return a copy of the Form that properly indicates that the Examiner has considered each of the references cited therein. Copies of the Information Disclosure Statement, accompanying Form PTO-1449, and the nineteen cited references are provided with this Amendment and Reply for the Examiner's convenience. As proof that the Information Disclosure Statement and Form PTO-1449 were filed with the PTO on January 24, 2002, copies of the date-stamped PTO post card and Cover Letter bearing the same date are also provided.

Election/Restriction

The Examiner has indicated that the restriction requirement mailed on July 31, 2003, has now been made final. The Examiner acknowledged Applicants' election of the Group I claims 1-8 and 34, and further-elected species having the compound identified in Example 4, (1*R**,2*R**)-2-(1-methylhydrazino)-1-indanol hydrogen maleate, with traverse. However, the Examiner indicated that he did not find Applicants' arguments persuasive. (Office Action, at page 2, paragraph 1.)

Applicants gratefully acknowledge the Examiner for indicating that "[p]rocess claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right," in the outstanding Office Action. Accordingly, Applicants assert that claims 35 and 36, which are directed to processes

for making compounds according to claim 1, should be rejoined with Group I claims 1-8 and 34 when the product claims are found allowable. *See*, M.P.E.P. § 821.04.

Rejoinder of claims 35 and 36 with claims 1-8 and 34 is respectfully requested.

Rejections Under 35 U.S.C. § 112

The Examiner has rejected claim 4 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants' regard as their invention. Specifically, the Examiner contends that claim 4 recites both a "broad" range/limitation ("alkyl") and a "narrower" range/limitation ("preferably methyl") for the definition of R², rendering the claim indefinite. (Office Action, at pages 3 and 4, paragraph 4.)

To expedite prosecution and without acquiescing to the propriety of the rejection, Applicants have amended claim 4 to delete the phrase "preferably methyl," thereby defining R² as "unsubstituted (C₁-C₄)alkyl." Applicants assert that claim 4, as amended, is clearly defined.

In view of the amendment to claim 4, the Examiner's rejection is rendered moot. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 1, 3, 5-8 and 34 under 35 U.S.C. § 102(b), as allegedly being anticipated by Gmeiner *et al.*, Chem. Abstracts 1992:426035 ("Gmeiner"). Specifically, the Examiner contends that Gmeiner purportedly discloses

certain 1,2,3,4-tetrahydronaphthalen-1-ol compounds encompassed within the definition of Applicants' Formula *I*. (Office Action, at pages 5 and 6, paragraph 10).

To expedite prosecution and without acquiescing to the propriety of the rejection, Applicants have amended claim 1 to delete the value 2 from the definition of *n* for compounds having Formula *I*. Applicants assert that no new matter has been introduced by this amendment since deletion of individual members of a Markush expression does not constitute new matter. *See, In re Johnson and Farnham*, 194 USPQ 187 (CCPA 1977).

Applicants assert that amended claim 1, and dependent claims 3, 5-8, and 34, do not recite the compounds disclosed in Gmeiner, or encompass any compound having the 1,2,3,4-tetrahydronaphthalene structural feature of the compounds disclosed in Gmeiner.

Applicants submit that each of the issues raised in the Examiner's rejection have been addressed, and respectfully request the Examiner's reconsideration and withdrawal of the rejection.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter.

The Examiner has indicated that claim 4 would be considered allowable if the claim were rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and include all of the limitations of claim 1, the base claim, and any intervening claims. (Office Action, at page 4, paragraph 6.)

In light of the amendment to claim 1, Applicants submit that the Examiner's objection to claim 4 has been properly addressed, and that the claim is allowable.

The Examiner has also indicated that claim 2 would be considered allowable if the claim were rewritten in independent form and included all of the limitations of the base claim and any intervening claims. (Office Action, at page 4, paragraph 7.)

For the reasons presented above, Applicants submit that amended claim 1 is allowable, rendering moot the Examiner's objection to claim 2.

Reconsideration and withdrawal of the Examiner's objections to claims 2 and 4 are respectfully requested.


Conclusion

All of the stated grounds of objection and rejection have now been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

for 
→ Ann E. Summerfield *Reg. No. 51,978*
Attorney for Applicants
Registration No. 47,982

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1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600